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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,563	04/07/2005	Takao Hasegawa	040894-7216	8997

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

REYNOLDS, STEVEN ALAN

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/530,563

Applicant(s)

HASEGAWA ET AL.

Examiner

Steven Reynolds

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-27 is/are pending in the application.
- 4a) Of the above claim(s) 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/7/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election without traverse of claims 10-21 in the reply filed on 12/28/2006 is acknowledged. Claims 22-27 are withdrawn from consideration.

Specification

2. The abstract of the disclosure is objected to because reference numerals should be in parenthesis. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

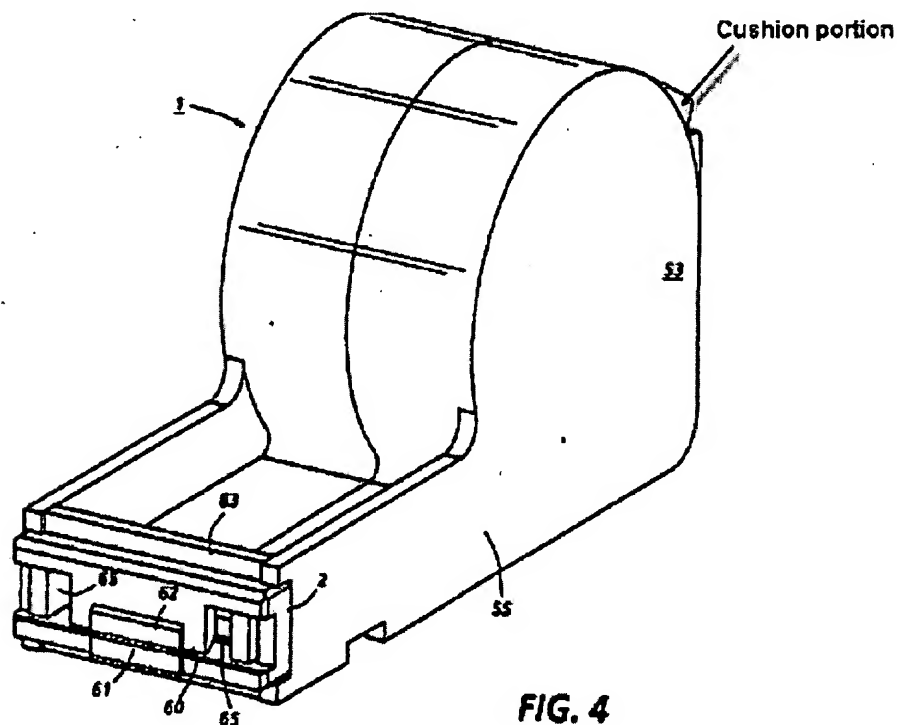
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10, 11 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Logtens (US 5,273,199). Logtens discloses a staple case (1) that contains a roll staple (54) formed by connecting unformed staples in a roll; a pull-out opening (slot 60) through which the roll staple is pulled out; an opening (56), formed at a

part of the staple case facing a circumferential surface of the roll staple (See Fig. 3 embodiment), through which a member (belt 14) for rotating the roll staple is brought into contact with the roll staple (See column 3, lines 47-52); a cushion portion (protrusion extending from the back side of the case - See figure below); a portion for positioning in a containing chamber (the bottom surface of the staple case rests on ribs 51 of the containing chamber); and a guide portion for guiding the staple case to a containing chamber (sides of the staple case allow it to be slid between side frame members 11 of the containing chamber).

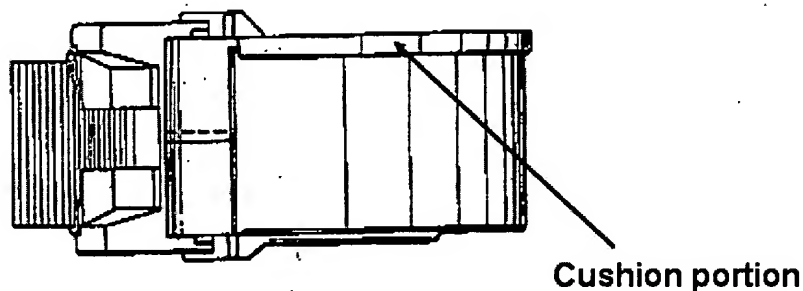


5. Claims 10-12, 14, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkel (US 3,602,414). Garfinkel discloses a staple case that contains a roll staple (19) formed by connecting unformed staples in a roll; a pull-out opening

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through which the roll staple is pulled out (See Fig. 5 embodiment); a cushion portion (See figure below); a first case half (13) and a second case half (14); and a weak portion (hinge member 15) on a joint between the first case half and second case half.

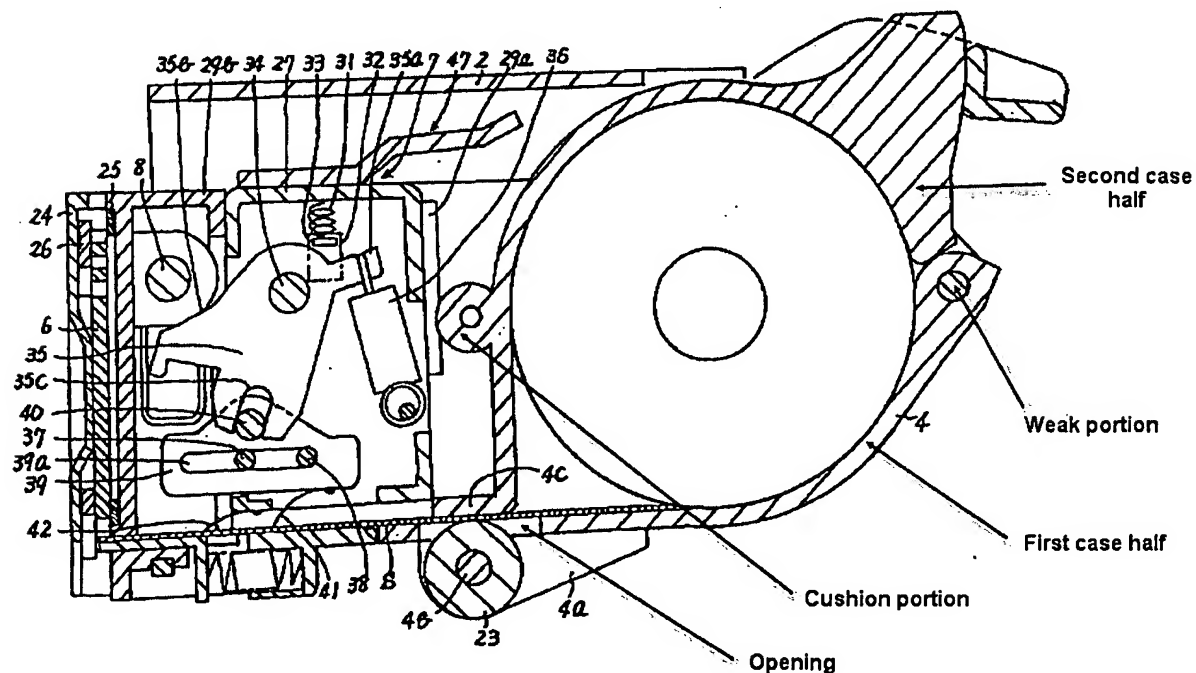
Regarding claim 12, since no reference point for the orientation of the case is claimed, the case of Garfinkel can be oriented in a position where the pull-out opening is at a vertical center of a front face.

**FIG. 2**

6. Claims 10, 11 and 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mochizuki (US 6,568,579). Mochizuki discloses a staple case (cartridge 4) that contains a roll staple formed by connecting unformed staples in a roll shape; a pull-out opening (opening wherein staples S pass beneath plate 4 – See Fig. 4 embodiment) through which the roll staple is pulled out; an opening (opening in lower portion of cartridge 4 wherein roller 23 is positioned – See Fig. 4 embodiment and Figure below), formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member (roller 23) for rotating the roll staple is brought into contact with the roll staple (See column 5, lines 21-26); a cushion portion (See figure

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below); a portion for positioning in a containing chamber (45 slides into 43 to position the cartridge into the containing chamber 2); a guide portion for guiding the staple case to a containing chamber (46 slides into 44 to guide the cartridge into the containing chamber 2); a first case half and a second case half (See Figure below); a first opening (opening wherein staples S pass beneath plate 4 – See Fig. 4 embodiment) through which the roll staple is pulled out; and a second opening (opening in lower portion of cartridge 4 wherein roller 23 is positioned – See Fig. 4 embodiment and Figure below) through which a member for rotating the roll staple is brought into contact with the roll staple, wherein the first opening is provided on the second case half, and the second opening is provided on the first case half (See Figure below); and a weak portion (hinge – See Figure below) on a joint between the first case half and the second case half.

**Fig. 4**

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki (US 6,568,579) in view of Haramiishi (US 7,048,165). Mochizuki discloses an upper/front face (Second case half – See Figure above) and a bottom/back face (First case half – See Figure above) having a different shape to the upper face. Mochizuki discloses all the limitations of the claims except for the specifics of the markings on the staple case.

However, Haramiishi teaches a cartridge casing (24) comprising an arrow on the side face of the case for the purpose of indicating the direction in which the case is inserted into the stapler (See Fig. 7 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the staple case of Mochizuki with the arrow marking on the side face as taught

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by Haramiishi in order to show the user the correct direction in which the staple case is to be inserted into the stapler.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Haramiishi (US D504,295), Mochizuki et al. (US 6,913,181), Yagi et al. (US 6,039,230) and Lerner (US 3,009,618).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SR

1/24/07


JILA M. MOHANDESI
PRIMARY EXAMINER